

Application No. 09/401,521  
Group Art Unit: 2645

- 2 -

Specifically, Norris fails to disclose use of a signaling network for carrying signaling information relevant to the establishment of call paths on a traffic carrying network. As clearly claimed in claims 21 and 29, this signaling network carries signaling information for telephone call traffic for a switched traffic network made up of a plurality of telephony switches. Norris simply discloses use of an ISDN network; no separate signaling network is disclosed. Without such an explicit disclosure, Norris cannot anticipate claims 21 and 29. Similarly, Norris does not disclose "receiving a signaling message from this signaling network generated in response to said incoming call, and received prior to establishment of a call path for the incoming call on the traffic carrying network", as claimed in independent claim 21; nor a "network interface adapted to receive signaling messages prior to establishment of associated call paths on said traffic carrying telephony network," as claimed in independent claim 29.

The Examiner appears to rely on column 2, lines 31-45 and FIG. 5 and 6 of Norris in support of his position that a signalling message in Norris is received prior to establishment of a call path (see Examiner's Response to Arguments). Careful review of column 2 reveals that Norris routes a call used to establish internet access to the IAS using conventional T1 carrier lines In order to connect an internet subscriber to the IAS.

As disclosed in column 2, lines 23-38 of Norris,

"Assuming that IAS 200 is not located in the same local dialing region as terminal DT1, then the telephone call will be routed via the public switched network (PSN) 100 e.g., the AT&T network. Specifically, upon receipt of the dialed number, then CO 25, in a conventional manner establishes a telephone connection to toll switch (TS) 105 and passes the called number and the ANI associate with the line 10 to TS 105. TS 105, in turn and in a conventional manner, establishes a connection to IAS 200 via communication path 150. In an illustrative embodiment of the invention, communications path

Application No. 09/401,521  
Group A1 Unit: 2645

- 3 -

150 may be one or more conventional T1 carrier lines ... TS 105 thus routes the call to IAS 200 by sending a so-called call set-up message over the signaling channel, in which the message identifies, inter alia, the T1 channel carrying the incoming call, ..." [EMPHASIS ADDED]

Thus, as this passage clearly indicates, in establishing this call to the IAS over the communications path, a signaling message is received at the IAS identifying a T1 channel to the IAS, with the call, and not prior to establishment of a call path for the incoming call, as claimed.

In any event, the call referred to in column 2 of Norris, is a call used to connect a subscriber line/terminal (DT1) to the internet, and not an "incoming call directed to a specified subscriber line, ... said specified subscriber line initially in-use to connect a data terminal to a data network", as claimed in claim 21. This passage of Norris similarly does not relate to an interface operable to "receive signaling messages prior to receipt of associated call paths" and "dispatch a data message indicative of said incoming call in communication with said data network" as claimed in claim 29.

This is evident at column 2, lines 41-45 of Norris

"IAS 200 then sends conventional data communications signals to the terminal DT1 software ... that is adapted to allow the subscriber to communicate/interface with Internet 300."

Therefore, any call set-up mechanism described in column 2, lines 22-45 are directed to a call set-up by a subscriber to the IAS, and not signaling of an incoming call to the subscriber, while the subscriber is connected to the internet.

Norris routes the incoming call to the subscriber connected to the internet to the IAS of Norris via an ISDN B (bearer) and D (data) channel (see column 5, line 48

Application No. 09/401,521  
Group Art Unit: 2645

- 4 -

— column 6, line 15). ISDN B channels carry traffic, and define a call path on a traffic carrying network. Specifically, Norris discloses,

"To re-route the call, TS 105 signals IAS 200 (PBX 235) that a call is being routed (forwarded) thereto via an idle B channel serving the particular call type, in which such signaling is transmitted over the associated D signaling channel. (As mentioned above, if the call is being forwarded to IAS 200, then the toll switch routes the call communications path 150-10. Calls directed to Internet 300, on the other hand, are routed over communications path 150-11.) The signaling information that is transported over a D channel of path 150-10 includes, inter alia, the forward-to-number used by CO 25 and the ANI of station S1. Such information may also include the calling party telephone number (station S2)."

Thus again, it appears in Norris that signaling messages are passed on D channels as call paths are established on the associated B channels. No signaling messages appear to be received prior to establishment of call paths.

FIG. 5 similarly relied on by the Examiner, clearly identifies that steps are performed after the RECEIVED INCOMING FORWARDED CALL. Again, there is simply no disclosure of steps taken in response to a signaling message, received prior to the establishment of the call path as claimed in independent claim 21 or 29.

As Norris simply does not explicitly disclose each and every element of claim 21 or 29, as required for anticipation under 35 USC 102, it cannot anticipate these claims. Withdrawal of the rejection of independent claims 21 and 29, and claims 22-28; 30-31; and 33-35 dependent thereon under 35 USC 102 in view of Norris is therefore respectfully requested.

The Examiner has further rejected claims 32, 36-37, 39-43, and 50-61 under 35 USC 103 in view of Norris and newly cited U.S. Patent No. 5,572,583 to Wheeler

Application No. 09/401,521  
Group Art Unit: 2645

- 5 -

(hereinafter "Wheeler").

As noted in responses to the previous Office Actions, in order to reject claims under 35 USC 103, the Examiner must establish that all claim elements exist in the art and a motivation to combine the art to arrive at the claimed invention at the date the invention was made.

Wheeler merely seems to evidence the existence of the AIN prior to the filing date of this application. Applicants do not dispute that the AIN is known. However, the Applicants do dispute that at the date the invention was made, knowledge of the existence of AIN and Norris would have lead a person of ordinary skill to use AIN to effect the dispatch of signaling messages over a data network, as claimed. Any such suggestion, it is submitted, is made with impermissible hindsight.

Specifically, as evidenced by Wheeler, the AIN is used to effect signaling and call completion over the telephone signaling network. It primarily allows benefits in conjunction with signaling provided to the PSTN for call handling. As such, Wheeler suggests an AIN platform to provide flexible call processing. Wheeler, for example, suggests use of AIN platform that provides flexible announcements and facilitates enhanced features such as speech recognition and mail services to PSTN subscribers.

Internet call notification devices, as disclosed by Norris, on the other hand, primary receive signaling from the PSTN and need not provide signaling to the PSTN. This is further evidenced by U.S. Patent No. 5,809,128 to McMullin ("McMullin") and U.S. Patent No. 5,982,774 to Foladare et al. ("Foladare").

Further, at the time of Norris, internet call notification appears to have been provided in co-operation with an internet access provider (IAP), or a separate server. At the date the invention was made, PSTN signaling messages were easily provided from the PSTN to the IAP or a separate server using other existing

Application No. 09/401,521  
Group Art Unit: 2645

- 6 -

technologies, such as existing call busy/no answer forwarding features disclosed by Norris, McMullin and Foladare. Use of AIN signalling, which required some modification to the PSTN network, appeared unnecessary in view of the ability to use the existing technologies. Indeed, it is submitted that, adapting the telephone network to primarily provide signaling messages from the PSTN using AIN for dispatch of data network notification (e.g. internet notification) messages, without establishing corresponding voice carrying PSTN channels was, at the date the invention was made (i.e. on or before Aug. 14, 1996), a radical departure from what is suggested by Norris. The present invention provides benefits to the PSTN operator in the delivery of internet notification – voice channels are not unnecessarily established. Providers of internet notification, such as Norris, although likely aware of the existence of AIN, appeared to have had little motivation to improve PSTN operation. As such, benefits provided in internet call notification through use of AIN would not have been recognized by a person of ordinary skill on the date the invention was made. In view of other existing technologies, they would not have been motivated to combine internet call notification with AIN. Any suggestion by the Examiner that persons of ordinary skill would have been so motivated, it is submitted, uses impermissible hindsight.

Withdrawal of the rejection of claims 32, 36-37, 39-43, and 50-61 under 35 USC 103 is therefore respectfully requested.

No new matter has been added by this amendment.

In view of the foregoing, favorable reconsideration and allowance of the present application are earnestly solicited.

Respectfully submitted,  
  
Matthew Zischka  
Registration No. 41,575

Application No. 09/401,521  
Group Art Unit: 2645

- 7 -

SMART & BIGGAR  
438 University Avenue  
Suite 1500, Box 111  
Toronto, Ontario  
Canada M5G 2K8

Telephone: (416) 593-5514  
Fax: (416) 591-1690

April 29, 2003  
92118-11C MZ/eel